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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,067	07/30/2003	William J. Thomas	100202150-1	9444

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INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

CHEN, ALAN S

ART UNIT	PAPER NUMBER
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2182

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/630,067	THOMAS, WILLIAM J.	
	Examiner	Art Unit	
	Alan S. Chen	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 22-43 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-18 is/are allowed.
- 6) ☒ Claim(s) 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/11/2007 has been entered.

Response to Arguments

2. Applicant's arguments, filed 1/11/2007, with respect to claims 1-21, have been fully considered and are persuasive. The 35 USC 102 and 112 rejections of claims 1-21 have been withdrawn. However, upon further consideration, a new ground(s) of rejection for claims 19-21 is made in view of US Pat. Pub. No. 2004/0243991 to Gustafson et al. (*Gustafson*).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 19 is rejected under 35 U.S.C. 102(e) as being anticipated by (*Gustafson*)

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Gustafson discloses a method of dynamically maintaining configuration information of a replaceable electronic module (*Figs. 2A and 2B show maintaining software/firmware of mobile handset*), comprising: storing configuration information in a persistent memory on the replaceable electronic module (*Fig. 1, element 111*), wherein the stored configuration information corresponds to an initial function assigned to the replaceable electronic module (*Fig. 1, element 115 is the firmware, element 125 contains software for the mobile handset, both being configuration information*); detecting when the replaceable electronic module is assigned a different function (*Fig. 1, element 113 is the update agent which detects if there is a new/different function which equates to a new version of firmware/software, Fig. 2A, element 211*); sending previously stored configuration information to the replaceable electronic module (*Fig. 1, update package is previously stored elsewhere, not on the handset, and downloaded to the handset*), wherein the previously stored configuration information corresponds to the assigned different function (*the update package has the new firmware/software*); and storing the configuration information sent to the replaceable electronic module in the persistent memory on the replaceable electronic module (*new firmware/software is downloaded to the non-volatile memory*), wherein the stored configuration information sent to the replaceable electronic module replaces at least a portion of the stored configuration information corresponding to the initial function (*Fig. 2A, new updated firmware/software is used*), and wherein the configuration information enables the replaceable electronic module to utilize a previously unenabled hardware capability of the replaceable electronic module or enables previously unenabled software to be

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executed by the replaceable electronic module (*new software/firmware allows use of new features or previously unabled features because of programming bugs*).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 20 and 21 are rejected under 35 USC 103(a) as being unpatentable over Gustafson in view of Hawkins et al. (*Hawkins*).

Gustafson discloses claim 19. Gustafson further discloses interfacing a mobile handset to a management server, which intrinsically has a disk drive, that has the new firmware/software updates to be executed on the mobile handset.

Gustafson does not disclose expressly part of the configuration information is used to enable connection to the hard drive on server.

Hawkins discloses software is required to establish communicate between a handheld device and a server (*Fig. 4*), due to the need to establish a communication

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protocol and standard interfaces between the mobile handset and server, as well as synchronization of information between the mobile handset and server.

Gustafson and Hawkins are analogous art because they are from the same field of endeavor in updating information between a handheld device and a server computer.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to download configuration for connection to a disk drive and execution of software on the disk drive.

The suggestion/motivation for doing so would have been communication protocols are frequently updated based on new version release to handle bugs, fixes, or overall improvements in the protocol. Hard disk drives may also be replaced with a new drive, which may require updating handheld interfacing software.

Allowable Subject Matter

8. Claims 1-18 are allowed.
9. Per claims 9-16 are allowed based on reasons stated in the previous office action.
10. Per claims 1-8, 17 and 18, the following is the statement of reasons for the indication of allowable subject matter: The prior art disclosed by the applicant and cited by the Examiner fail to teach or suggest, alone or in combination, ***all*** the limitations of the independent claim(s) (*claims 1 and 17*), particularly a method of automatically maintaining configuration information of a replaceable electronic module with the step of storing at least some of a first configuration information received from the replaceable electronic module in a persistent memory not on the replaceable electronic module

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(claims 1-8); a method upgrading a replaceable electronic module with the step of storing a modified configuration information in a persistent memory located off the replaceable electronic module (claims 17 and 18).


Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan S. Chen whose telephone number is 571-272-4143. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim N. Huynh can be reached on 571-272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ASC
03/1/2007


3/1/07